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10/728,494	12/05/2003	David Czaja	98646.00002	9727

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EXAMINER

LEGESSE, NINI F

ART UNIT	PAPER NUMBER
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3711

DATE MAILED: 08/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/728,494

Applicant(s)

CZAJA ET AL.

Examiner

Nini F. Legesse

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2-4, 7 and 16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 5, 6, 9-15 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 8 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 06/18/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

This application contains claims directed to the following patentably distinct species of the claimed invention:

- **Species I** is illustrated in figures 1, 2, and 5-14.
- **Species II** is illustrated in figures 3 and 4.
- **Species III** is illustrated in figures 15, 16, 17, and 18.
- **Species IV** is illustrated in figure 19.
- **Species V** is illustrated in figures 20 and 21.

A telephone call was made to **Attorney Basam Nabulsi** on **08/04/04** to request an oral election to the above restriction requirement, and a provisional election was made without traverse to prosecute the invention of Species (reading on Figs. 15-18 and claims 1,5,6,8-15, and 17-20). Affirmation of this election must be made by Applicant in replying to this office action. And claims 2,3,4,7, and 16 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to non elected species.

### ***Typing Errors***

- In claim 1 line 6, please add a semi colon after the word "shaft".
- In claim 9 line 2, please change "busing" to - - bushing - -.
- In claim 12 line 3, please add a period after the word "means".

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "ballast" element in claim 8, line 1; the "lighting element" in claims 11 and 18; and the "sound-emitting element" in claims 12 and 19 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 11 and 18** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In this case, Applicant has briefly indicated that a light mechanism could be incorporated in his invention (see the last paragraph of page 20 of the instant specification). As shown in figures 15 and 16 of the instant application, the second means (212) is a dampener housing and there is also a shock bushing (210) associated with the second means. With a dampener housing and a shock bushing, how would a light element illuminate in response to the slidable member moving into contact with the second means? For example, where would a switch for the lighting mechanism be located to activate the lighting mechanism in response to the impact of the slider and the housing? The specification has insufficient structure disclosed for the use of the "lighting element" as disclosed in claims 11 and 18 that would allow one to make and use the invention without undue experimentation.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 11 and 18** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear as to how and where the "lighting element" as disclosed in claims 11 and 18. With the presence of dampener housing (212) and shock bushing (210) as shown in Fig. 16, how does a lighting element would illuminate in response to the slidable member moving into contact with the second means?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 5, 6, 13, 14, 15, and 17** are rejected under 35 U.S.C. 102(b) as being anticipated by Karell (US Patent No. 4,295,832).

Karell discloses an educational toy comprising:

**With respect to claim 1,**

- A shaft (22) having an upper portion (the area of rod 22 close to detent 32), a lower portion (the area of rod 22 close to detent 30) and a central portion extending therebetween and defining a longitudinal axis (see Fig. 1);
- A member (40) slidably mounted with respect to the central portion of the shaft and adapted and configured for movement between the upper portion and the lower portion of the shaft (see Fig. 1);
- First means (32) located in the upper portion of the shaft for preventing the slidable member from sliding over the upper portion of the shaft;
- Retaining means associated at least in part with the first means (the magnetic force between 40 and flat side 28), said retaining means functioning to restrain axial movement of the slidable member along the shaft until a pre-selected restraining force is overcome (column 2, lines 57-65 indicates that handle 36 and detent 32 are removable from rod 22 so that the magnetic members 24 could be re-applied in any desired sequence. Thus if one eliminates the set of item 40 with numeral 5 that is located on the right side of Fig. 1, then the next set 40 wherein numeral 4 is shown will be connected to the flat side 28 of detent 32 due to the magnetic polarization of the two elements. Then they will have to apply some force to detach the left block element (40) from detent 32 for another arrangement of the elements).
- Second means (30) located at the lower portion of the shaft for preventing the slidable member from becoming disassociated from the shaft (see Fig. 1).

- With respect to the intended use of the apparatus as stated in the first line of the claim, this recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. And it is noted that the apparatus of Karell is capable of being used as an apparatus for a swing.

**With respect to claim 5**, the retaining means includes one or more magnetic elements positioned within the slidable member (for example the set 40 as shown on Fig. 1 wherein numeral 4 is shown has more than one magnetic elements 24) and a magnetically responsive structure associated with said first means (see all the negative and positive polarities of elements 24 as shown in Fig. 1).

**With respect to claim 6**, the retaining means includes one or more magnetic elements positioned within the first means (if the first set of 40 that is identified as numeral 5 is removed as discussed above in claim 1, and if in addition the third set of 40 that shows numeral 3 is removed, then second set of 40 that shows numeral 4 will attach to detent 32 providing detent 32 with plurality of magnetic elements) and a magnetically responsive structure associated with said slidable member (see Fig. 1, set of 40 that shows numeral 3 will be attracted to the combination of the detent 32 and set 40 identified with numeral 4 ).

**With respect to claim 13**,

- A shaft (22) that defines a longitudinal axis;
- An upper retainer (32) that is positioned at a first location relative to said shaft;
- A lower retainer (30) that is positioned at a second location relative to said shaft;



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- A slidable member (any of the sets that are identified as numeral 1,2,3, 4, or 5) that is mounted with respect to said shaft for movement between said upper retainer and said lower retainer, and
- A retaining mechanism associated at least in part with said upper retainer member (the magnetic force of item 32 with side 28), said retaining mechanism functioning to retain said slidable member in juxtaposition with said upper retainer member until a predetermined force is effected through swinging of said shaft (column 2, lines 57-65 indicates that handle 36 and detent 32 are removable from rod 22 so that the magnetic members 24 could be re-applied in any desired sequence. Thus if one eliminates the set of item 40 with numeral 5 that are located on the right side of Fig. 1, then the next set 40 wherein numeral 4 is shown will be connected to detent 32 due to the magnetic attraction of the two components. Then a user would need to apply some force to detach the left block element (40) from detent 32).
- With respect to the intended use of the apparatus as stated in the first line of the claim, this recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. And it is noted that the apparatus of Karell is capable of being used as an apparatus for a swing.

**With respect to claim 14**, the retaining mechanism (the magnetic force between 40 and flat side 28) includes magnetic elements (the negative and the positive charges as shown in Fig. 1) positioned within said slidable member (any of the sets that are shown

as numeral 1, 2, 3, 4, or 5) and a magnetically responsive structure being associated with said upper retainer (see the negative and positive polarities of the element as shown in Fig. 1).

**With respect to claim 15**, the position of the magnetic elements is repositionable within the slidable member (column 2, lines 57-65 indicates that handle 36 and detent 32 are removable from rod 22 so that the magnetic members 24 could be re-applied in any desired sequence) so as to adjust said predetermined force (since the magnetic members 24 are capable of being removed, if one removes one magnetic element 24 from the slidable member 40, then the set 40 will inherently have less force and if one adds more magnetic elements 24 to the slide set 40 then the magnetic force of the slid element will increase inherently).

**With respect to claim 17**, the retaining mechanism (the magnetic force between 40 and flat side 28) includes magnetic elements (the negative and the positive charges as shown in Fig. 1) positioned within said upper retainer and a magnetically responsive structure being associated with said slidable member (any of the sets that are shown as numeral 1, 2, 3, 4, or 5 has positive and negative polarities).

**Claims 1, 10, and 13** are rejected under 35 U.S.C. 102(b) as being anticipated by L. T. Stumpf (US Patent No. 2,135,648).

Stumpf discloses a practice golf club comprising:

**With respect to claim 1**,

- A shaft (2) having an upper portion (see Fig. 1 where indicia 2d is shown), a lower portion (see Fig. 1 the area below indicia 2a) and a central portion (see Fig. 1 the area below around indicia 2b) extending therebetween and defining a longitudinal axis (see Fig. 1);
- A member slidably mounted (B) with respect to the central portion of the shaft and adapted and configured for movement between the upper portion and the lower portion of the shaft;
- First means (A) located in the upper portion of the shaft for preventing the slidable member from sliding over the upper portion of the shaft;
- Retaining means associated at least in part with the first means (the magnetic force of member A. column 3, lines 9-10 indicates that element A is formed of a magnetized substance), said retaining means functioning to restrain axial movement of the slidable member along the shaft until a pre-selected restraining force is overcome (the magnetized nature of member A will hold member B in place, see column 5, lines 33-48 and the magnetized nature of member A will hold members A and B in contact until member B is released from the magnetic attraction of member A as a result of the centrifugal force created by the swing of the golf club as discussed in column 3, lines 60-67. In addition please note that first member A is adjustable to different points in the length of the shaft causing the amount of swing necessary to overcome the magnetic attraction of member A. See column 3, lines 41-67. Also see column 5, lines 33-48), and

- Second means (C) located at the lower portion of the shaft for preventing the slidable member from becoming disassociated from the shaft.

**With respect to claim 10, the swing relates to a sport of golf (see Fig. 1).**

**With respect to claim 13,**

- A shaft (2) that defines a longitudinal axis;
- An upper retainer (A) that is positioned at a first location relative to said shaft;
- A lower retainer (C) that is positioned at a second location relative to said shaft;
- A slidable member (B) that is mounted with respect to said shaft for movement between said upper retainer and said lower retainer, and
- A retaining mechanism associated at least in part with said upper retainer member (the magnetic force of item A. Column 3, lines 9-10 indicate that element A is formed of a magnetized substance), said retaining mechanism functioning to retain said slidable member in juxtaposition with said upper retainer member until a predetermined force is effected through swinging of said shaft (the magnetized nature of member A will hold members A and B in contact until member B is released from the magnetic attraction of member A as a result of the centrifugal force created by the swing of the golf club as discussed in column 3, lines 60-67. Also see column 5, lines 33-48).

**Please note that claims 11 and 18 have 112 1<sup>st</sup> and 112 2<sup>nd</sup> rejections.**

**However, as best understood, claims 11 and 18 are rejected as follows.**

**Claims 1, 11, 13, 18 and 20** rejected under 35 U.S.C. 102(b) as being anticipated by Moore (US Patent No. 3,677,553).

Moore discloses a practice golf club comprising:

**With respect to claim 1,**

- A shaft (19) having an upper portion, a lower portion and a central portion extending therebetween and defining a longitudinal axis (see Fig. 3);
- A member slidably mounted (17) with respect to the central portion of the shaft and adapted and configured for movement between the upper portion and the lower portion of the shaft;
- First means (16) located in the upper portion of the shaft for preventing the slidable member (15) from sliding over the upper portion of the shaft;
- Retaining means (14) associated at least in part with the first means, said retaining means functioning to restrain axial movement of the slidable member along the shaft until a pre-selected restraining force is overcome (see column 1, lines 64 –68 and column 2, lines 1-26), and
- Second means (24) located at the lower portion of the shaft for preventing the slidable member from becoming disassociated from the shaft.

**With respect to claim 13,**

- A shaft (19) that defines a longitudinal axis;
- An upper retainer (16) that is positioned at a first location relative to said shaft;
- A lower retainer (24) that is positioned at a second location relative to said shaft;

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- A slidable member (15) that is mounted with respect to said shaft for movement between said upper retainer and said lower retainer, and
- A retaining mechanism associated at least in part with said upper retainer member (14), said retaining mechanism functioning to retain said slidable member in juxtaposition with said upper retainer member until a predetermined force is effected through swinging of said shaft (see column 1, lines 64 –68 and column 2, lines 1-26).
- **With respect to claims 11 and 18**, a lighting element (22) associated with the second means (24) and wherein the lighting element (22) illuminates in response to the slidable member moving into contact with the second means (see column 1, lines 64 –68 and column 2, lines 1-26).

**With respect to claim 20**, during normal use and operation of the Moore's device as discussed above, the method steps as claimed would inherently be performed.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 9, 12, and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Stumpf in view of Hurdzan (US Patent No. 2,950,115).

**With respect to claim 9**, Stumpf fails to show a shock pushing. However, Hurdzan discloses a second means that includes a lower retainer (see the component that is positioned close to the golf club head as shown in Fig. 3), a shock bushing (26) and a dampener housing (20). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Stumpf with a shock pushing as taught by Hurdzan for providing an audible sound as well as for providing a cushioned shock to the golf club shaft and handle for indicating to the golfer by sound and by feel the point of greatest club head speed as discussed in column 4, lines 17-27 of the Hurdzan's reference.

**With respect to claims 12 and 19**, Stumpf fails to explicitly state the use of a sound-emitting element that is to be actuated in response to the slidable member moving into contact with the second means. However, Hurdzan discloses the use of sound-emitting element (26) that is to be actuated in response to the slidable member moving into contact with the second means (see column 3, lines 6-35). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the device of Stumpf with a sound-emitting element as taught by Hurdzan for providing an audible sound so that a golfer could properly develop his timing as stated in column 1, lines 26 of the Hurdzan's reference.

***Allowable Subject Matter***

**Claim 8** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: none of the prior art teach wherein a ballast is positioned within the slidable member, when affixed in the manner claimed in combination with the other recited features.

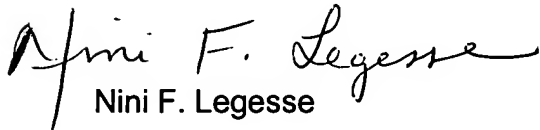
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nini F. Legesse whose telephone number is (703) 605-1233. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vidovich Greg can be reached on (703) 308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Nini F. Legesse

08/04/04